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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,158	11/15/2001	Jeffrey D. Kenyon	020366-086100US	3861
20350	7590	10/20/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			POND, ROBERT M	
		ART UNIT	PAPER NUMBER	
		3625		

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/991,158	KENYON, JEFFREY D.	
	Examiner	Art Unit	
	Robert M. Pond	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 July 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2,4,6-12,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2,4,6-12,22 and 23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

The Applicant canceled Claims 1, 3, 5, and 13-21, amended Claims 2, 4, 6, 7, 8, and newly added independent Claims 22 and 23. All pending claims (2, 4, 6-12, 22, and 23) were examined in this non-final Office Action.

Response to Arguments

Rejection under 35 USC 101 (Claims 13-21)

The Applicant canceled Claims 13-21. Rejection under 35 USC 101 is withdrawn.

Rejection under 35 USC 102(e) and 103(a)

Applicant's arguments, see Remarks, filed 26 July 2004, with respect to the rejection(s) of claim(s) under 2, 4, 6-12, 22, and 23 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Covington. Covington discloses an interactive system and method for shopping that separates the shopping process from the buying process. Covington discloses a consumer using a computer remotely connected to online web merchants over the Internet, the consumer browsing and creating wish lists and shopping cart lists and downloading these lists from the web sever to the

remotely connected computer to the PDA or directly to the PDA. Tarvydas was withdrawn but is considered pertinent prior art.

Official Notice (regarding username)

The Applicant did not traverse the examiner's assertion of official notice. The common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse or adequately traverse the examiner's assertion of official notice (MPEP 2144.03(C)).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted element is: the computer capable of communicating with the portable device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 2, 4, 6, 8-12, and 22 are rejected under 35 USC 102(e) as being anticipated by Covington et al. (patent application number 2003/0154135 hereinafter referred to as “Covington”).**

Covington teaches all the limitations of Claims 1-5, 8-16 and 18-21. For example, Covington discloses an interactive system and method for shopping that separates the shopping process from the buying process. Covington discloses a consumer using a computer remotely connected to online web merchants over the Internet, the consumer browsing and creating wish lists and shopping cart lists and downloading these lists from the web sever to the remotely connected computer to the PDA or directly to the PDA (see at least abstract; Fig. 1 (10); pages 1-2, 0012-0016; page 13, 0149). Covington further discloses:

- Accessing the information items at a website: in-store, in-mall and online shopping using a web browser to navigate (see at least Fig. 1 (28, 32); page 4, 0066).

- Searching a database: web site includes a web server, database organized for rapid search and retrieval (see at least Fig. 1 (38); page 4, 0069).
- Placing the information items in an information shopping cart at the website: consumer selects products and places selected items into shopping cart; transfers wish list to shopping cart (see at least Fig. 11 (312, 410); Fig. 14 a-b; page 8, 0106; page 9, 0110-0111).
- Transmitting the information shopping cart having the selected information items to a portable device: server transmits scan lists, wish lists, shopping cart data directly to PDA via a wireless data connection; downloads via an interface cradle; retailer name displayed (please note examiner's interpretation: branding information); shopping portal domain name used to access web site (please note examiner's interpretation: necessary for any device used to transact purchases from shopping cart) (see at least Fig. 28; page 4, 0068; page 13, 0149; page 15, 0166).
- Naming information: consumer names wish lists and transfers named wish lists to PDA as noted above (see at least page 9, 0110; page 16, 0175).
- Directory: provides a directory (see at least page 4, 0069)
- Languages and protocols: HTML, Java, XML, JavaScript, SHTML (see at least page 4, 0069).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claim 7 is rejected under 35 USC 103(a) as being unpatentable over Covington (patent application number 2003/0154135), in view of Communications Today (Paper # 2, PTO-892, Item: U hereinafter referred to as "CT").**

Covington teaches all the above as noted under the 102(e) rejection and teaches a) consumer viewing transmitted information from the web site using various formats, and b) consumers using a PDA to interact with a web shopping service, but does not disclose the user selecting the format. CT teaches a wireless Internet service that allows users to choose from four display screen formats as their starting point for browsing the wireless Web (U: see at least page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Covington to allow consumers to select a screen format as taught by CT, in order to accommodate consumer preferences, and thereby attract consumers to the commerce service.

3. Claim 23 is rejected under 35 USC 103(a) as being unpatentable over Covington (patent application number 2003/0154135), in view of Reed et al. (patent number 5,862,325 hereinafter referred to as “Reed”).

Covington teaches an interactive system and method for shopping that separates the shopping process from the buying process. Covington teaches a consumer using a computer remotely connected to online web merchants over the Internet, the consumer browsing and creating wish lists and shopping cart lists and downloading these lists from the web sever to the remotely connected computer to the PDA or directly to the PDA (see at least abstract; Fig. 1 (10); pages 1-2, 0012-0016; page 13, 0149). Covington further teaches:

- Accessing the information items at a website: in-store, in-mall and online shopping using a web browser to navigate (see at least Fig. 1 (28, 32); page 4, 0066).
- Searching a database: web site includes a web server, database organized for rapid search and retrieval (see at least Fig. 1 (38); page 4, 0069).
- Placing the information items in an information shopping cart at the website: consumer selects products and places selected items into shopping cart; transfers wish list to shopping cart (see at least Fig. 11 (312, 410); Fig. 14 a-b; page 8, 0106; page 9, 0110-0111).
- Transmitting the information shopping cart having the selected information items to a portable device: server transmits scan lists, wish lists, shopping

cart data directly to PDA via a wireless data connection; downloads via an interface cradle; retailer name displayed (please note examiner's interpretation: branding information); shopping portal domain name used to access web site (please note examiner's interpretation: necessary for any device used to transact purchases from shopping cart) (see at least Fig. 28; page 4, 0068; page 13, 0149; page 15, 0166).

- Naming information: consumer names wish lists and transfers named wish lists to PDA as noted above (see at least page 9, 0110; page 16, 0175).
- Directory: provides a directory (see at least page 4, 0069)
- Languages and protocols: HTML, Java, XML, JavaScript, SHTML (see at least page 4, 0069).
- Yellow pages directory:

Covington teaches all the above as noted under the 103(a) rejection and teaches a) communicating information to consumers, and b) providing directory service and indexes but does not disclose a yellow pages directory. Reed teaches transferring data, metadata, and method from a provider computer to a consumer computer. Reed further teaches a yellow pages directory service used to classify and represent a large database of objects communicated to consumers (see at abstract; least col. 98, lines 62-67). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Covington to implement a yellow pages directory as taught by Reed, in order to classify

and communicate a large database of objects to consumers, and thereby attract consumers to the service.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

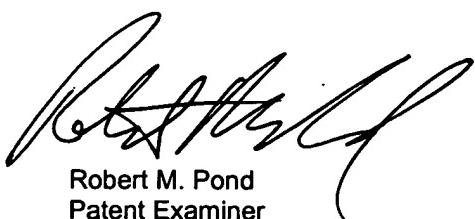
Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Robert M. Pond
Patent Examiner
October 18, 2004